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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,468	02/12/2002	James F. McGuckin JR.	1908	8951

7590

07/10/2003

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EXAMINER

THISSELL, JEREMY

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 07/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,468

Applicant(s)

MCGUCKIN ET AL. *CH*

Examiner

Jeremy T. Thissell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 24 and 25 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-16 and 19 is/are allowed.
- 6) ☒ Claim(s) 1-10, 17, 18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-23, drawn to a cannula apparatus with deployable tines, classified in class 604, subclass 164.09.
- II. Claims 24 and 25, drawn to a method of treating a lesion, classified in class 604, subclass 500.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process can be done with a different product because the process does not require nearly as many specifics about the device as do the device claims.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Neil Gershon on 18 June 2003 a provisional election was made WITHOUT traverse to prosecute the invention of group I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24 and 25 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the deployed position" in lines 3 and 4. There is insufficient antecedent basis for this limitation in the claim. Note that the claims from which claim 9 depends claims multiple deployed positions, thus, it is unclear to which position claim 9 refers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 10, 20, and 22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by McGuckin et al (US 6,425,887).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Behl (US 5,275,611).

McGuckin teaches all the claimed subject matter except for the tracks/projection. Behl teaches the well-known mechanism of having slide tracks to guide coaxial tubes in their longitudinal sliding relative to one another. It would have been obvious to one of ordinary skill in the art to incorporate such tracks on McGuckin in order to maintain

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proper rotational alignment and facilitate deployment of the tines. It would have been further obvious to provide more than one of those tracks, since duplication of parts is within the level of skill in the art.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Behl as applied to claim 4 above, and further in view of Foster (US 6,217,559).

McGuckin as modified by Behl teaches all the claimed subject matter except for a detent retaining member. Foster teaches this well-known engineering component at the end of tracks. It would have been obvious to one of ordinary skill in the art to provide such a retaining member on the device of McGuckin as modified by Behl, in order to maintain the tines in a deployed position, and appropriately release them when the operation is completed.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Imran (US 6,425,887).

McGuckin teaches all the claimed subject matter except for having a tine that comes out in substantial axial alignment with the longitudinal axis of the outer tube. Imran teaches a substantially similar device that does have such a straight tine. It would have been obvious to incorporate the straight tine of Imran on the device of McGuckin to enable treatment of the area immediately distal to the end of the device as part of the target treatment area.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Horzewski et al (US 5,873,865).

McGuckin teaches all the claimed subject matter except a collagen plug deployer to be placed in the elongate member when the tines have been removed. However, McGuckin does teach that other surgical devices can be inserted through the outer tube. (col. 5, lines 17-19) Horzewski teaches that it is known to form TMR channels and fill them with collagen (col. 2, lines 5-9). In view of McGuckin's teaching of other devices for use through the lumen, and Horzewski's teaching of collagen plugs in ablation-formed channels, it would have been obvious to include a collagen plug deployer with the device of McGuckin, an ablation device, to establish such collagen-filled TMR channels.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGuckin in view of Foster.

See discussion of Foster above.

Allowable Subject Matter

Claims 11-16 and 19 are allowable over the prior art of record

The prior art does not teach a tine deployment device, wherein the tines are deployable to two different positions, and that the actuator is moved in different

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directions for each deployable position or where the actuator is movable to the second position without moving to the first position. This claim language is evidently aimed at excluding devices as prior art that merely have two stages of deployment, where the actuator is simply pushed further out to reach a further deployed position. It has successfully done so.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy T. Thissell whose telephone number is (703) 305-5261. The examiner can normally be reached on 8:30-7:00 Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached at (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

jt
June 30, 2003


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
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